

submitted, along with the Business Wire release – plus the Declaration of the inventor – which collectively show the invention prior to May 5, 1999.

In the Office Action, with further respect to the Declaration of Scott Rader, the Examiner contends:

“Because Applicant provides no other evidence or facts to support the limitation, the declaration is insufficient to overcome the rejection....”

In response, the Examiner’s attention is respectfully drawn to 35 U.S.C. Sec. 132 and Rule 104. Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to “the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*”. A similar requirement is made by Rule 104(a)(2), which requires “...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has been denied this entitlement, based upon the treatment of the Declaration of Scott Rader.

Scott Rader has declared that

“I have no financial interest in the outcome of this matter, and I am not being paid to do my declaration, which I am instead providing because I personally know that Kevin Donovan made and used his invention in this patent application on a date prior to May 5, 1999, because I was among the users referenced in Paragraph 7 of Kevin Donovan’s Supplemental Declaration.”

The Office Action contends that “the declaration is insufficient”, but other than contending that there was “no other evidence” (which the Applicant has traversed above and is a separate issue), the Examiner has not explained why the Declaration of Scott Rader itself is insufficient. He was there, witnessed and used the invention, and has no stake in the outcome of this patent application. His Declaration cannot be dismissed as “insufficient” for no reason, other than the absence of some other evidence. No “...*reasons ... together with such information as may be useful in judging the propriety of continuing prosecution...*” have been provided with respect to the Declaration of Scott Rader itself being “insufficient,” e.g., does the Examiner contend that Scott Rader is untruthful or is there some other explanation for the contention that “the

declaration is insufficient” – one cannot tell from the Office Action, especially in connection with the corroborating evidence all consistent with operation of the invention prior to May 5, 1999. It is noted that independent corroboration by a non-inventor is entitled to evidentiary weight in connection with an interference, and an interference is being sought in a related case Ser. No. 10/824,038. If such independent corroboration is entitled to weight in an interference, the Examiner must provide some justification in a non-interference application. The Examiner must explain why the Declaration of Scott Rader is “insufficient,” other than by pointing to (overlooking) other evidence. Absent the required “...reasons ... together with such information”, the rejection is improper pursuant to Rule 104 and Sec. 132, and further because the PTO bears the burden of proof in withholding a patent (see *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993)) the PTO has not established a prima facie case of unpatentability in view of the totality of the evidence.

APPLICANT CLAIMS LARGE ENTITY STATUS. The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235.

Please direct all correspondence to the undersigned at the address given below.

Respectfully submitted,



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